

REMARKS/ARGUMENTS

In the restriction requirement dated September 13, 2007, the Examiner delineated the following claimed inventions as being patentably distinct:

Group I, Claim(s) 1-29, drawn to biochips and kits;

Group II, Claim(s) 32-33, drawn to methods of making biochips; and

Group III, Claim(s) 34-46, drawn to methods of operating kits.

Applicants provisionally elect with traverse Group I (Claims 1-29, 30, and 31).

Examiner please note that while Claims 30 and 31 were not specifically mentioned in Group I, they do in fact properly belong with Group I since “kits” is specifically recited as a member of Group I.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims of the restricted groups are patentably distinct. The claims of Groups I and II are related as product and process for making said product, and are considered to be interdependent and should be examined together especially wherein the sole disclosed utility of the product is that recited in the specification (specifically Group III).

The claims of Group I are integrally linked with the claims of Groups II and III as combination/subcombination. The claims of Groups II and III further define the invention of Group I. The Examiner has failed to show other than allege that the claims of Groups II and III have other uses besides that shown by the instant invention. There is a commonality that exists between Groups I, II, and III. It is a technical relationship that involves the same feature, and it is this technical feature that defines the contribution which each of the groups taken as a whole makes over the prior art.

Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility.

Applicants respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application.

Further, the MPEP at § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct and independent inventions.”

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as an alternative within a single claim.

The Examiner asserts that Groups I, II, and III do not relate to a single general inventive concept under PCT Rules 13.1 and 13.2 because they lack the same corresponding special technical feature. The Examiner, however, has not considered that the claims in each group are considered related inventions under 37 C.F.R. § 1.475(b) in which the inventions are considered to have unity of invention. Applicants submit that while PCT Rules 13.1 and 13.2 are applicable, 37 C.F.R. § 1.475(b) provides in relevant part, that “a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to . . . (3) a product, process specially adopted for the manufacture of said product, and the use of said product.”

Moreover, Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. As the Office has not shown any evidence that a restriction requirement should now be required when the International Preliminary Examination Report did not, restriction is believed to be improper.


For the reasons set forth above, Applicants request that the Restriction Requirement be withdrawn.

Applicants request that if the invention of Group I is found allowable, withdrawn Groups II and III which include all the limitations of the allowable claims be rejoined (M.P.E.P. § 821.04).

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

Respectfully submitted,

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